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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,367	08/16/2001	Dietmar Schill	450117-03511	3593

20999 7590 03/28/2005

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NEW YORK, NY 10151

EXAMINER

HASHEM, LISA

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 03/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/931,367

Applicant(s)

SCHILL ET AL.

Examiner

Lisa Hashem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

FINAL DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 63 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 63, the limitations: 'wherein said time information is structured so that it comprises at least one relative time to a full hour if said corresponding additional service is transmitted every hour, or at least one offset to the time of the beginning of the day plus at least one repetition rate of said corresponding additional service' are not found in the specification or the drawings. The claimed invention would require a further explanation of how the time information is structured. One of ordinary skill in the art would not be able to modify a broadcast signal to include this type of time information. Appropriate action is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 25-67 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent No. 6,587,127 by Leeke et al, hereinafter Leeke.

Regarding claim 25, Leeke discloses a method of accessing at least one additional service temporarily included within a respective main service provided by a respective service provider (providing audio content), said method using a receiving device or client apparatus (Fig. 1: 104, 106) adapted to be connected to said respective service provider (col. 4, lines 8-30 and lines 50-67), comprising the steps of: extracting from a main service (audio content available) presently received by said receiving device service information (events) about at least one of said corresponding additional services (content from special occurrences, conventions, announcements, news, and sports events); accessing (by a point-and-click operation) at least one of said additional services about which service information was extracted (selected) according to said respective extracted service information; storing said extracted service information in said receiving device (in the smart card of the receiving device; Fig. 1: 140, 146); updating said stored service information each time the extracting step (selection) is executed (col. 8, lines 21-27; col. 10, lines 5-14; col. 14, lines 14-30).

Regarding claim 26, the method according to claim 25, wherein Leeke further discloses the extracting step further comprises extracting a service identification (Event) and a service name (Sporting Event 4) of at least one of said additional services (Fig. 13, 480; col. 16, lines 10-25).

Regarding claim 27, the method according to claim 25, wherein Leeke further discloses the extracting step further comprises extracting time information including transmission times of at least one of said additional services (Fig. 11; Fig. 13, 480).

Regarding claim 28, the method according to claim 25, wherein Leeke further discloses the extracting step further comprises extracting service channel information of at least one additional service showing which service channel will be used when transmitting a corresponding additional service from a corresponding service provider via said service channel to said receiving device, respectively (Fig. 13, 480, wherein other events can be viewed; col. 14, lines 52-63).

Regarding claim 29, the method according to claim 28, wherein Leeke further discloses the accessing step further comprises connecting said receiving device to at least one of said service channels according to said service channel information and said time information (col. 16, line 43 – col. 17, line 3).

Regarding claim 30, the method according to claim 25, wherein Leeke further discloses activating said receiving device, or necessary parts thereof, for receiving a service during time intervals in which an additional service is transmitted from the corresponding service provider to said receiving device (a notification sent of an event or program that may be of interest based on expressed interest of the user or monitoring user activity); and returning said receiving device or

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said parts thereof into the state before activation during the rest of the time, wherein said processes of activating and returning are carried out on the basis of said stored service information or said latest extracted service information (col. 17, lines 4-14).

Regarding claim 31, the method according to claim 25, wherein Leeke further discloses managing the time order of different accessing processes, when said additional services assigned thereto are transmitted at the same time to said receiving device, respectively, wherein said managing process is performed according to said stored service information or said latest extracted service information (col. 16, line 43 – col. 17, line 3).

Regarding claim 32, the method according to claim 25, wherein Leeke further discloses subscribing to a service list containing entries representing available additional services of respective service providers, wherein said process of subscribing changes said stored service information (col. 16, line 43 – col. 17, line 3; Fig. 14).

Regarding claim 33, the method according to claim 30, wherein Leeke further discloses if the receiving device is in its activated state, only accessing that additional services which are transmitted over service channels used by said main services presently received or that have a specific priority level (in preset list) (Fig. 14; col. 10, lines 5-15)

Regarding claim 34, the method according to claim 32, wherein Leeke further discloses the step of eliminating subscribed services in said service list which preferably have no specific priority level if the power resources of said receiving device fall below a predetermined limit (period of inactivity) (col. 6, lines 11-20).

Regarding claim 35, the method according to claim 25, wherein Leeke further discloses the step of monitoring all additional services provided by a corresponding service provider

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during the time in which said receiving device receives a main service from said corresponding service provider (col. 8, lines 6-12; col. 14, lines 52-63; Fig. 10).

Regarding claim 36, the method according to claim 25, wherein Leeke further discloses the step of storing (in preset) service data extracted from said at least one additional service, after having accessed them in the accessing step, in said receiving device, said stored service data being accessible (Fig. 14; col. 10, lines 5-15).

Regarding claims 37-49, please see the rejections to claims (25 and 30), 26, 27, 28, 29, 25, 25, 31, 32, 33, 34, 35, and 36, respectively, to reject claims 37-49.

Regarding claims 50-62, please see the rejections to claims (25 and 33), 26, 27, 28, 29, 25, 25, 30, 31, 32, 34, 35, and 36, respectively, to reject claims 50-62.

Regarding claim 63, please see the rejections to claims 25 and 27 and further (Fig. 11, 245), to reject claim 63. Wherein an additional service may be archived and repeat at different times or days (col. 14, lines 52-63).

Regarding claims 64-65, please see the rejections to claims 28 and 26, respectively, to reject claims 64-65.

Regarding claim 66, Leeke discloses an apparatus for accessing at least one additional service provided by at least one service provider, said apparatus (see Fig. 1) comprising: receiving means connectable via at least one service channel to said at least one service provider for receiving at least one additional service from said at least one service provider (please see rejection to claim 25 above; col. 8, lines 3-31); a user interface (see Fig. 2) for informing a user and for controlling said apparatus by said user; and a processing unit connected to said receiving means and to said user interface, the processing unit comprising: a scheduler means connected to

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said processing unit for controlling said process of accessing said at least one additional service; a service information memory means for inherently storing service information needed by said scheduler means to control said apparatus; and a service data memory means inherently connected to said processing unit for storing service data extracted by said receiving means from said at least one additional service according to said service information, wherein said scheduler means comprises a wake-up control means connected to said receiving means and said processing unit for activating said receiving means and said processing unit or necessary parts thereof for receiving a service during time intervals in which an additional service is transmitted from the corresponding service provider to said receiving device, returning said receiving device or said parts thereof into the state before activation during the rest of the time, said processes of activating and returning being carried out on the basis of said stored service information or latest extracted service information (see Fig. 1; col. 16, line 43 – col. 17, line 32; please see rejection to claim 30), wherein the storing of information and scheduler means is stored in the smart card.

Regarding claim 67, the apparatus according to claim 66, wherein Leeke further discloses a conditional access means to decrypt an encrypted service to permit access (col. 6, lines 36-43).

Response to Arguments

5. Applicant's arguments, see Amendment, filed 10-29-2004, with respect to the rejection(s) of claim(s) 25-67 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made. Please see all rejections above.

6. Per Applicant's arguments, Leek clearly discloses all limitations recited in claim 25. Leek clearly discloses storing extracted service information (events) in a smart card of the client device and updating said stored information each time service information is extracted from a received main service by the user of the device. Additional service information is accessed by a point-and-click operation by the user within a respective main service. The storing of extracted service information or an updating of said stored service information each time it is extracted is done by updating the smart card that is connected to the client device, depending on the user's preferences (please see rejection to claim 1 above and all passages listed there). Wherein the user chooses to save these changes based on a preference and a preset list is updated with the user's preferences. A player is reset to its previous state after a notification is displayed to the user of events or content of interest either specified by the user or based on monitoring activity of the user's actions (please see rejection to claim 30 above and all passages listed there).

7. Applicant's arguments with respect to claims 25-67 have been considered but are moot in view of the new ground(s) of rejection. Please see all rejections above.

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Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- European Patent Application No. EP 975,109 by Suzuki et al disclose a digital broadcasting method for transmitting required information, wherein transmission schedule information including the kind of the utilization data, a receiver identifier indicating a target of transmission, and the transmission time at the which said data is to be transmitted, is multiplexed in a program to be transmitted

9. Accordingly, this action is **FINAL**.

10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9306 (for formal communications intended for entry)

Or call:

(571) 272-2600 (for customer service assistance)

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30.

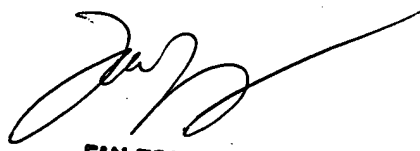
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

LH

lh

March 21, 2005



FAN TSANG
SUPERVISORY PATENT EXAMINER
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